

Applicant: Murray et al.
Serial No.: 10/605,684
Group Art Unit: 2179

REMARKS

Claims 1-39 remain the subject application with claims 1, 20, 24, and 35 in independent form.

Applicant submits herewith a Request for Continued Examination (RCE) and an appropriate extension of time along with any necessary fees. Also, Applicant submits herewith a Declaration under 37 C.F.R. 1.132 from Mr. Peter Hochstein, a person of at least ordinary skill in the art.

Claims 1-13, 15-33, and 35-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wink Communications (<http://web.archive.org/web/20001206040800-wink.com/>) (hereinafter Wink I) in view of Bove titled Adding Hyperlinks to Digital Television.

Applicant respectfully traverses the §103 rejection. Specifically, Applicants submit that the Examiner has not established a *prima facie* case of obviousness. First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there is no reasonable expectation of success of combining the references. Finally, the prior art references when combined do not teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure.

The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the teachings of Wink I into the teachings of Bove, because the references solve the same problem of providing interactive TV with hyperlinked

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data.

It is well known that evaluating a *prima facie* case of obviousness requires that the claimed invention *must be considered as a whole* and the references *must be considered as a whole* and must suggest the desirability and thus the obviousness of making the combination. Further, the references must be viewed *without the benefit of impermissible hindsight* vision afforded by the claimed invention.

Referring to the Declaration from Mr. Hochstein, there are numerous indicia why the Examiner's mere conclusion regarding obviousness is incorrect. As stated by Mr. Hochstein, when viewing the references as a whole and without the use of impermissible hindsight, the references teach away from making the combination suggested by the Examiner. Even though Wink I and Bove solve the same problem, the methods used by the references to solve the problem are distinct and incompatible such that the disclosures teaches away from the combination.

Specifically, Wink I overcomes the problem of providing information by merely disposing an overlay on top of the media stream and displaying the selectable regions in the overlay. In other words, the solution in Wink I was not to design user-selectable regions over the object in the media stream. Instead, Wink I provides the overlay separate fro the video signal as shown on page 10. The idea of a simple overlay is reinforced by Wink I supporting the use of Interactive Communicating Application Protocol (ICAP). ICAP is a compact protocol that allows for transmission in limited data bandwidth of analog broadcasts. In other words, Wink's separate overlay is designed to consume small amounts of bandwidth to be able to be transmitted in ICAP.

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Bove, on the other hand, developed a complex segmentation mask algorithm that identifies pixels in every frame of the media stream to position the user-selectable region over the object. In other words, Bove provides a single, edited video that incorporates the hyperlinks therein. The segmentation mask for every frame requires large amounts of processing and memory in order to handle the segmentation masks created for every second of video for many objects. As a result, Mr. Hochstein, as one of ordinary skill in the art, would not have been motivated to combine the overlay method of Wink I with the segmentation mask of Bove.

Additionally, Mr. Hochstein states that there is no reasonable expectation of success if the references could be combined. Since Wink I and Bove each utilize different and distinct methods to provide the object information, i.e. overlay versus mask segmentation, the combination of techniques does not have a reasonable expectation of success. Wink I reduces the consummation of bandwidth by merely providing a single overlay for display over the video, whereas Bove requires large amounts of bandwidth to accommodate the edited video with the segmentation mask for each frame or the large number of frames, i.e., one frame every second (1800 frames).

Finally, even if the references could be combined, each and every feature of the subject invention would not be disclosed, taught, or suggested. Referring to claim 1, the combination does not disclose, teach, or suggest defining a user-selectable region in a layer separate from the media stream *and without accessing individual frames of the media stream*. The user-selectable region *tracks a position* of the object present in the media stream. The combination also does not disclose, teach, or suggest the user-selectable region

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is positioned *in the layer over the object* such that the user-selectable region *tracks the position of the object during playback of the media stream.*

Referring to claim 20, the combination fails to disclose, teach, or suggest, a second component of a video signal is transmitted having a layer with user-selectable regions *tracking a position of objects present in the media stream* and linked to information associated with the object. The combination further fails to disclose, teach, or suggest *synchronizing the user-selectable region within the layer to a position of the object in the media stream without accessing individual frames of the media stream.*

With reference to claim 24, the combination fails to disclose, teach, or suggest, a layer for disposition adjacent the media stream during playback and having a user-selectable region *tracking a position of the object in the media stream to synchronize the user-selectable region within the layer to the position of the object in the media stream without accessing individual frames of the media stream during playback.*

Referring to claim 35, the combination fails to disclose, teach, or suggest, an editor defining *a user-selectable region tracking a position of the object in the media stream without accessing individual frames of the media stream* and defining a link between the user-selectable region and information associated with the object. The combination further fails to disclose, teach, or suggest a layer disposed adjacent the media stream during playback and presenting the user-selectable region for selection by the user to access the information such that *the user-selectable region is synchronized within the layer to the position of the object in the media stream without accessing individual frames of the media stream.*

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In view of the above and in light of Mr. Hochstein's Declaration, the §103 rejection should be withdrawn and claims 2-13, 15-19, 21-23, 25-34, and 36-39 are believed to be allowable.

On pages 12-13 of the Final Office Action, the Examiner states "Also note page 3, paragraph 1 –'without accessing individual frames by use of an algorithm to figure out position of a tracked object'". Applicants have reviewed the identified page and paragraph and been unable to locate the cited passage. As such, Applicants have attempted to address the Examiner's concerns, however, without accurate citations Applicant can not definitively respond. Thus, Applicant would appreciate correction of the cite.

Claims 14 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wink Communications in view of Murray et al. (United States Patent No. 6,636,237) in further view of Wink Communications as cited by the Examiner (hereinafter Wink II).

The §103(a) rejection of claims 13 and 34 is inappropriate and should be withdrawn. The Examiner relies upon the parent application to the subject application, i.e. Murray et al., in arriving at the §103(a) rejection. In order to apply a reference under §103, it must qualify as prior art under §102. The subject application claims priority to Murray et al. and these claims are supported by Murray et al., thus Murray et al. is not prior art.

Therefore, the §103(a) rejection of claims 14 and 34 should be withdrawn and claims 14 and 34, which depend directly or indirectly from independent claims 1 and 24, are also believed to be allowable.

Accordingly, it is respectfully submitted that the Application is presented in condition for allowance, which allowance is respectfully solicited. The Commissioner is authorized to

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charge our Deposit Account No. 08-2789 for any fees or credit the account for any overpayment.

Respectfully submitted,

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